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DORSEY & WHITNEY LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
SUITE 3400  
1420 FIFTH AVENUE  
SEATTLE, WA 98101

EXAMINER

BULLOCK JR, LEWIS ALEXANDER

ART UNIT	PAPER NUMBER
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2126

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DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/153,994

Applicant(s)

HAMMOND, NANCEY J.

Examiner

Lewis A. Bullock, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Affidavit or Declaration***

1. The declaration/affidavit filed on 9/16/02 under 37 CFR 1.131 has been considered but is ineffective to overcome the Miyamoto and Shinomura references.
2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Miyamoto and Shinomura references. The evidence demonstrates conception of the invention prior to the effective date. However, as disclosed in 37 CFR 1.131 there is no evidence of due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application (See also MPEP 715.03, Formal Requirements for Affidavits and Declarations / Three Ways to Show Prior Invention). Applicant states in the response that the invention was diligently reduced to practice, however, the examiner has no evidence of this assertion.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-3, 15-19, 21, 23, 25-27, 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over BIRDWELL (US 5,793,973) in view of "Messaging's next blockbuster hit" by COX.

As to claim 15, BIRDWELL teaches a method in a computer system for delivery of an electronic message (downloaded data), the method comprising: determining whether after sending of the electronic message to a recipient (client computer) a pre-determined period of time has elapsed without receiving a confirmation (confirmation) of the electronic message to the recipient; and when it is determined that the pre-determined period of time has elapsed without receiving the confirmation, sending another electronic message (col. 14, line 43 – col. 14, line 29; col. 3, lines 33-36; col. 4, lines 60-65; col. 11, lines 45-57). It would be obvious that the pre-determined period of time is used since the determining of the confirmation and sending of the message is periodically repeated. However, BIRDWELL does not explicitly state that confirmation message is a delivery confirmation message.

COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious that the server system requests a delivery confirmation in the mail message sent to the client system of BIRDWELL. Therefore, it would be obvious to combine the teachings of BIRDWELL with the teachings of COX in order to determine whether the recipient has actually opened the message or has merely received it (pg. 6).

As to claim 1, BIRDWELL teaches a method in a computer system for a sender (server computer system) of an electronic message (downloaded data) to ensure that the message is delivered and reviewed by intended users (client computer system)

comprising: sending an electronic message to a plurality of intended recipient users (broadcast); and without user intervention, when the notification from the recipient user is not received by the sender within a waiting period, resending the electronic message to the recipient user (col. 14, line 43 – col. 14, line 29; col. 3, lines 33-36; col. 4, lines 60-65; col. 11, lines 45-57). It would be obvious that the waiting period is used since the determining of the confirmation and the resending of the message is periodically repeated. It would also be obvious and well known in the art that in order to send an electronic message one has to compose the message, and indicate the intended users by selecting delivery recipients (to addresses) and review recipients (cc addresses). However, BIRDWELL does not teach the requesting of delivery notification or review notification.

COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious that the server system requests a delivery confirmation (delivery) and reviewed confirmation (read) in the mail message sent to the client system of BIRDWELL. Refer to claim 15 for the motivation to combine.

As to claim 2, BIRDWELL teaches the resending is performed for each recipient not returning a notification (col. 14, line 43 – col. 14, line 29; col. 3, lines 33-36; col. 4, lines 60-65; col. 11, lines 45-57). It would be obvious that the waiting period is used since the determining of the confirmation and the resending of the message is periodically repeated. It would also be obvious and well known in the art that in order to

send an electronic message one has to compose the message, and indicate the intended users by selecting delivery recipients (to addresses) and review recipients (cc addresses).

As to claim 3, It would be obvious to one skilled in the art that when one sends a reminder message to a previous message the priority of the message is increased.

As to claim 16, COX teaches requesting the confirmation (pg. 6, fifth paragraph).

As to claims 17 and 18, COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious that in order to detect that a message is reviewed (read), one has to monitor the electronic message.

As to claim 19, BIRDWELL teaches periodically retransmitting data (email message) when a confirmed receipt is not received (col. 14, line 43 – col. 14, line 29; col. 3, lines 33-36; col. 4, lines 60-65; col. 11, lines 45-57). It would be obvious that the retransmitting is performed automatically.

As to claim 21, It would be obvious to one skilled in the art that when one sends a reminder message to a previous message the priority of the message is increased.

As to claim 23, It would be obvious to one skilled in the art that when one sends a reminder message to a previous message the priority of the message is increased.

As to claim 25-27, It would be obvious that since the message is periodically retransmitted until a confirmation is received (col. 11, lines 54-57), that if a confirmation is not received in the second pre-determined time interval, a third message is sent.

As to claims 32 and 33, reference is made to a computer readable medium which corresponds to the method of claims 15 and 19 and is therefore met by the rejection of claims 15 and 19 above.

As to claim 35, refer to claim 33 for rejection.

5. Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over BIRDWELL (US 5,793,973) in view of "Messaging's next blockbuster hit" by COX and MIYAMOTO (US 6,327,046).

As to claim 6, refer to claim 15 for rejection. However, the period of time is user specified. None of the references cited teach the period of time is user-specified. MIYAMOTO teaches determining if a confirmation to an electronic message is received in a user specified period of time (retransmission time interval) (col. 9, lines 3-16) and if not, sending an electronic message (prompting mail) (col. 10, line 62 – col. 12, line 8; col. 3, line 6-28). Therefore, it would be obvious to combine the teachings of

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BIRDWELL with the teaching of COX and MIYAMOTO in order to facilitate the handling of replies of e-mails (col. 1, lines 23-30; col. 1, line 64 – col. 2, line 10).

As to claim 7, refer to claim 19 for rejection.

As to claim 8, refer to claim 20 for rejection.

As to claim 9, refer to claim 21 for rejection.

As to claim 10 and 11, COX teaches requesting confirmation of the delivery to the recipient (pg. 6, fifth paragraph). It would be obvious that the recipient is queried in order to determine if the message is delivered.

As to claim 12, COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious that if a confirmation message is requested by a client computer in response to any message sent to the server, that in response to a server requested read receipt, a server computer can send a delivery receipt to the client computer notifying the client computer of receipt of its sent read receipt.

As to claim 13, refer to claim 19 for rejection.



As to claim 14, refer to claim 24 for rejection.

6. Claims 28-31 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over MIYAMOTO (US 6,327,046) in view of "Messaging's next blockbuster hit" by COX.

As to claim 28, MIYAMOTO teaches a method for a sender (transmitting device) of an electronic message to ensure that the electronic message is reviewed by a recipient (receiving device), the computer-implemented method comprising: determining whether after sending of the electronic message to a recipient a specified amount of time has elapsed without receiving an confirmation from the recipient (col. 3, lines 6-28), when it is determined that the period of time has elapsed without receiving the indication, automatically requesting a confirmation from the sender to send a second electronic message (prompting setting means); and when the confirmation is received from the sender, sending the second electronic message (col. 3, lines 6-28; col. 9, lines 3-16 ; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8). However, MIYAMOTO does not teach the indication is a review confirmation.

COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious that the server system requests a reviewed confirmation (read) in the mail message sent to the client system of MIYAMOTO. Therefore, it would be obvious to combine the teachings of MIYAMOTO with the

teachings of COX in order to determine whether the recipient has actually opened the message or has merely received it (pg. 6).

As to claim 36, MIYAMOTO teaches a computer system for ensuring that an electronic message is reviewed by a recipient, comprising: a message sender (transmitting device); a message tracker (register); and a message processor (CPU) (col. 3, lines 6-28; col. 9, lines 3-16 ; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47). However, MIYAMOTO does not teach the indication is a review confirmation.

COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious that the server system requests a reviewed confirmation (read) in the mail message sent to the client system of MIYAMOTO. Refer to claim 28 for the motivation to combine.

As to claim 29, MIYAMOTO teaches the electronic message is sent to a plurality of recipients and receiving a specification (prompting setting means) of the amount of time for each recipient such that automatic requesting of the confirmation (sending a prompting message) is performed when no indication is received within the specified amount of time (col. 3, lines 6-28; col. 9, lines 3-16 ; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47).

As to claim 30, MIYAMOTO teaches graphically presenting to the sender a request to send the electronic message (col. 5, line 57 – col. 7, line 52; col. 8, line 63 – col. 9, line 2).

As to claim 31, MIYAMOTO teaches when it is determined that the period of time has elapsed without receiving the indication, automatically requesting a confirmation from the sender to send a third electronic message within a second amount of time (col. 3, lines 6-28; col. 8, line 63 – col. 9, line 16; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8).

As to claim 37, MIYAMOTO teaches the message sender is further for receiving indications (replies) and for receiving a specification (via prompting setting means) of the amount of time for each recipient wherein the message tracker determines whether the sent message was reviewed within the specified amount of time and the message process for sending the second message for each recipient that did not review the sent message within the specified time (sending a prompting message) (col. 3, lines 6-28; col. 9, lines 3-16 ; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47).

As to claim 38, It would be obvious that since the message is retransmitted when no reply is sent within the specified amount of time that as long as there is no reply to the message, it will be subsequently resent multiple times.

7. Claims 20, 22, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over BIRDWELL in view of COX as applied to claim 19 above, and further in view of MIYAMOTO (US 6,327,046).

As to claim 20, BIRDWELL and COX substantially disclose the invention. However, neither reference explicitly teaches the cited limitation. MIYAMOTO teaches the period of time is based on past performance of the recipient (col. 12, lines 15-32; col. 11, lines 18-26). Therefore, it would be obvious to combine the teachings of BIRDWELL with the teaching of COX and MIYAMOTO in order to facilitate the handling of replies of e-mails (col. 1, lines 23-30; col. 1, line 64 – col. 2, line 10).

As to claim 22, BIRDWELL and COX substantially disclose the invention. However, neither reference explicitly teaches the cited limitation. MIYAMOTO teaches the another electronic message is a reminder message (prompting mail) sent to the recipient distinct from the sent electronic message (col. 3, lines 6-28; col. 9, lines 3-16 ; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47). Refer to claim 20 for the motivation to combine.

As to claim 34, reference is made to a computer readable medium which corresponds to the method of claim 22 and is therefore met by the rejection of claim 22 above.

8. Claims 4, 5, and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over BIRDWELL in view of COX as applied to claim 15 above, and further in view of SHINOMURA (US 6,108,709).

As to claim 4 and 5, BIRDWELL and COX substantially disclose the invention. However, neither reference explicitly teaches the cited limitation. SHINOMURA teaches determining a user able to prompt review of the electronic message by the recipient user; and sending an electronic message to the determined user when no notification is received from the recipient within the waiting period (condition) (col. 15, lines 21-30 ; col. 16, lines 33-37; col. 16, line 58 – col. 17, line 13). Therefore, it would be obvious to combine the teachings of BIRDWELL with the teachings of COX and SHINOMURA in order to provide a superior data sending apparatus with an alternate forwarding function (col. 2, lines 35-52).

As to claim 24, BIRDWELL and COX substantially disclose the invention. However, neither reference explicitly teaches the cited limitation. SHINOMURA teaches the electronic message is sent to a second recipient distinct from the recipient, and the another message prompts the second recipient to facilitate review by the recipient of the sent electronic message (col. 15, lines 21-30; col. 16, lines 33-37; col. 16, line 58 – col. 17, line 13). Refer to claim 4 for the motivation to combine.

***Response to Arguments***

9. Applicant's arguments filed 9/16/02 have been fully considered but they are not persuasive. Applicant argues that Birdwell does not teach or suggest determining whether after sending of the electronic message to a recipient a user-specified period of time has elapsed without receiving a confirmation of delivery of the electronic message to the recipient; and when it is determined that the user-specified period of time has elapsed without receiving the confirmation, sending another electronic message. The examiner disagrees. Birdwell teaches sending data to each client computer system and receiving and storing confirmations from those systems and any system in which confirmation has not been received periodically resending the data until a confirmation is received (col. 13, line 43 – col. 14, line 29). It would be obvious that since the sending the data to client systems that has not sent a confirmation is periodically repeated until a confirmation is received that this is automatic. Cox teaches that a recipient can be requested for a received or return receipt as part of the message. Therefore, Birdwell with the combination of Cox adequately teaches the limitation as disclosed.

Applicant argues the same arguments as above in referring to claims 1-3. The examiner disagrees that the cited references do not teach the limitation and refers back to the response above to illustrate such.

Applicant argues the same arguments as above in referring to claims 15-19, 21- 23, and 25-27. The examiner disagrees that the cited references do not teach the limitation and refers back to the response above to illustrate such.

Applicant argues the same arguments as above in referring to claims 32, 33, and 35. The examiner disagrees that the cited references do not teach the limitation and refers back to the response above to illustrate such.

Therefore, the rejection is hereby maintained as disclosed above since the cited references teach the limitations as disclosed.

***Pertinent Art of Record***

US Patent 5,930,471 teaches a sender system can send an email message to a plurality of receiver systems requesting a response. Subsequently to the sending of the email message, the sender system accesses the message to determine how many receiver systems have responded and if any receiver systems have not responded sending them a reminder message. This is substantially similar to the functionality of claim 6, 15, 28, and 32 wherein the interval from the time when the message is sent until when the sender accesses the message status is the user-determined period of time.

US Patent 5,978,836, sent along with paper no. 7, teaches a fault detection and recovery handling of an initial system sends an email and if a receipt of the email is not received within a predetermined interval a potential fault is detected and the recovery is performed. Recovery includes resending the email, sending a notification email to another email address or the manager of the address not responding (col. 15, lines 41-67). This is substantially similar to the functionality of claims 1, 6, 15, 32, and 36.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (703) 305-0439. The examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alvin E. Oberley can be reached on (703) 305-9716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0286.



ALVIN OBERLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

lab  
November 27, 2002